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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/622,517	08/17/2000	Mitsuru Tanabe	KOIK-Q9495	8570
22850	7590	01/23/2006	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			BAYAT, BRADLEY B	
			ART UNIT	PAPER NUMBER
			3621	
DATE MAILED: 01/23/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/622,517

Applicant(s)

TANABE ET AL.

Examiner

Bradley B. Bayat

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-8, 10-13, 15 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-8, 10-13, 15 and 16 is/are rejected.
- 7) ☒ Claim(s) 10, 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/25/2005 has been entered.

Status of Claims

As per amendment filed on September 9, 2005, claims 2, 3 and 16 have been amended. Thus, claims 2-8, 10-13, 15 and 16 remain pending.

Response to Arguments

Applicant's arguments with respect to claim noted above have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

Claims 10 and 12 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 10 refers to "checking data" and "checking step" of claim 2; however, it is unclear how it further limits the subject matter of the claim it depends from. Claim 2 fails to recite a step or recitation of "checking."

Furthermore, the use of optional language "possible" preceding modification fails to further limit the claim 2.

Claim 12 fails to further limit independent claim 2 since it recites that duplication of data is allowed when discriminating information that prevent such duplication are not present in the database. Claim 2 is directed to preventing duplication of data based on predetermined parameters and therefore claim 12 fails to further the subject matter of its dependent claim.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 10 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "possible" in claim 10 renders the claim indefinite. The term "possible" is not defined by the claim and such intended use language renders the claim indefinite. It is unclear what the scope of a "possible" modification entails.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 2-8, 10-13, 15 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Aramaki et al., US 6,298,022 B1.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

As per the following claims, Sugiyama discloses:

Claims 2, 3 (Currently Amended): An information processing method/ program storage medium comprising:

- storing information for discriminating contents duplicated in the past and temporal data as to a previous start time of duplication of said contents into a database;
- acquiring the information for discriminating content to be duplicated;

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- deciding whether copying of the contents discriminated by the discriminating information is allowed in accordance with a comparison between the temporal data stored in the database and current time; and
- duplicating the contents in accordance with said decision whether copying of the content is allowed, wherein the duplication of the content is prohibited when an interval of time between the current time and the previous start time of duplication of said content specified by the temporal data stored in the database is less than predetermined amount of time (column 2, line 32-column 3, line 67; see figures 8, 13, 16 and associated text).

Claim 4 (Previously Presented): The information processing method according to claim 2 wherein said contents is reproduced from an information storage medium (figures 8, item 90 with associated text).

Claim 5 (Previously Presented): The information processing method according to claim 4 wherein said information recording medium is a compact disc (figures 8, item 90).

Claim 6: (Previously Presented): The information processing method according to claim 2 wherein the discriminating contents is the ISRC (figures 14, 15, 19 and associated text).

Claim 7: (Previously Presented): The information processing method according to claim 2 wherein the discriminating information for discriminating the contents is the TOC (column 13, line 57 – column 14, line 51).

Claim 8: (Previously Presented): The information processing method according to claim 2 wherein the ISRC as the discriminating information for discriminating contents is read out at said storage step from the information recording medium and, if the ISRC is not stored in said information recording medium, data of the TOC is utilized as said discriminating information (column 25, lines 6-67).

Claim 10 (Previously Presented): The information processing method according to claim 2, further comprising: a step of checking data in said database; said checking step detecting possible modification using a hash function (column 19, lines 10-67).

Claim 11 (Previously Presented): The information processing method according to claim 2 wherein said predetermined amount of time is a fixed value (column 23, lines 40-50).

Claim 12 (Previously Presented): The information processing method according to claim 2 wherein duplication of the content is allowed when said discrimination information and temporal data of the content to be duplicated is not stored in the database (columns 30-31).

Claim 15 (Previously Presented): The information processing method according to claim 1, further comprising: updating the previous start time of duplication in the database to the present time when the duplication of content is permitted (column 22).

Claim 16 (Currently Amended): The program storage medium including computer program instruction for causing a computer to implement an information processing method according to Claim 3, further comprising: updating the previous start time of duplication in the database to the present time when the duplication of content is permitted (column 14).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Aramaki, in view of Moskowitz et al., US 5,889,868.

As per claim 13, Aramaki discloses a method of acquiring, storing and duplicating content based on specified and predetermined criteria, i.e., ISRC, TOC and time. Aramaki does not expressly disclose the use of a watermarking technique to encrypt such data.

However, Moskowitz teaches various implementations of digital watermarks that can embed any data for protection, detection and prevention of content misuse (column 2, line 25-column 4, line 47; column 8, lines 13-31). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Aramaki's information processing method to utilize a watermarking encryption mechanism to embed data in the recording medium to provide further integrity to the content protection and duplication in a digital environment, as per teachings of Moskowitz.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 2-8, 10-13, 15 and 16 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6,298,022 B1.

Although the conflicting claims are not identical, they are not patentably distinct from each other because Claims 1-26 of U.S. Patent No. 6, 298,022 B1 recite all the limitations of claims 2-8, 10-12, 15 and 16. Claim 13 of the instant application differs since it further recites additional claim limitations including wherein a watermark encryption technique is used. However, it would have been obvious to a person of ordinary skill in the art to modify by removing the limitations directed to watermark encryption from the claims of the present application since the claims of the present application and the claim recited in U.S. Patent No. 6,298,022 B1 actually perform a similar function. It is well settled that the omission of an element and its function is an obvious

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expedient if the remaining elements perform the same function as before. *In re Karlson*, 136 USPQ 184 (CCPA 1963). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd. App. 1969). Omission of a reference element whose function is not needed would be obvious to one of ordinary skill in the art.

Although the Examiner has pointed out particular references contained in the prior art(s) of record in the body of this action, the specified citations are merely representative of the teachings in the art as applied to the specific limitations within the individual claim. Since other passages and figures may apply to the claimed invention as well, it is respectfully requested that the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- US Patent 5,805,551 to Oshima et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley B. Bayat whose telephone number is 571-272-6704. The examiner can normally be reached on Tuesday - Friday 8 a.m.-6:30 p.m. and by email: bradley.bayat@uspto.gov.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached regarding urgent matters at 571-272-6712.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(571) 273-8300 - Official communications; including After Final responses.

(571) 273-6704 - Informal/Draft communications to the examiner.

A handwritten signature in black ink, appearing to read "Bradley Bayat", with a stylized flourish extending from the end.

Bradley B. Bayat, Esq.
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January 7, 2006